

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 8-9 have been cancelled. Claim 12 has been added. Claims 2, 7, and 10 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Claim 12 corresponds in scope to Claim 9 which, together with Claims 10-11, was indicated as being allowable upon having been rewritten in independent form, including all of the limitations of the base claim and any intervening claim(s). Accordingly, Claim 12, which is claim 9 so rewritten, and Claims 10-11, now dependent on Claim 12, are in condition for allowance.

The Examiner rejected Claim(s) 1, 2, 4, 6, 7 under 35 U.S.C. § 102(b) as anticipated by Leonardo et al., U.S. Patent No. 3,652,003 (Leonardo). Claims 1-2 and 4-8 were also rejected under 35 U.S.C. §102(b) as being anticipated by De Caro et al., U.S. Patent No. 3,171,131 (De Caro). It is respectfully submitted that Claims 1-7 are patentable over the cited references.

Specifically, Claim 1 recited that the second region which extends from the first region in a direction toward an end of a bolt guide remote from the combustion chamber, has an inner diameter smaller than the inner diameter of the first region for braking a fastening element during a driving process.

As explained in the specification (page 4, second paragraph), braking of the fastening element causes deceleration of the setting piston. Therefore, in the first phase of combustion in the combustion chamber, a sufficiently high energy is built up, which permits subsequently to drive the fastening element with full power. This, in turn, insures a complete return of the piston into its initial position.

Providing a bolt guide with a region of a reduced inner diameter for braking a fastening element displaceable through the bolt guide during a setting or driving process is not disclosed in the prior art, including Leonardo and De Caro.

In Leonardo, the second region (with a smaller diameter) extends from the first region having a greater diameter in a direction away from the free end of the bolt guide and does not design to brake a fastening element during the driving process. The first region of Leonardo with a greater diameter is designed to allow the end of the drive piston to easily drive into the muzzle. The federal Circuit has mandated that 35 U.S.C. §102 requires no less than “complete anticipation. . . [a]nticipation requires the presence in a single prior art disclosure of all elements

of a claims invention arranged as in the claim” (emphasis added). Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, S.A. v. Cooper Life Science, 32 U.S.P.Q. 2d at 1019 (Fed. Cir. 1994). Verdegaal Bros. Inc. v. Union Oil Co., 2 U.S.P.Q. 2d at 1053 (Fed. Cir. 1987).

Even if we assume *arguendo*, that Leonardo disclose all (?) of the elements of Claim 1, they are clearly arranged not as in the Claim.

Since Leonardo fails to disclose each and every feature of independent Claim 1, Leonardo, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

De Caro likewise does not anticipate or makes obvious the present invention. In De Caro, the ball (48) is located, together with the spring (49) in a recess (46c) provided on one side of the guide axis. The assembly ball (48)-spring (49) is designed for retaining the fastening element against falling-out in the vertical position of the tool (column 4, lines 71-75). The elastic force of the rubber spring (49) would be insufficient to cause braking of the movable fastening element.

According to case law, in order to meet a “means-plus-function” limitation, the prior art must (1) perform the identical function recited in the means limitation

and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578 27 U.S.P.Q. 2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 U.S.P.Q. 2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 U.S.P.Q. 2d 1382, 1386 (Fed. Cir. 1989).

In De Caro, the ball-rubber spring assembly does not and cannot perform the same function (an identical function) as the second region of Claim 1.

In view of the above, it is respectfully submitted that De Caro does not anticipate or makes obvious the present invention, as defined by Claim 1, and that Claim 1 is patentable over De Caro.

Claims 2-7 depend on Claim 1 and are allowable as being dependent on an allowance subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that

such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to: Commissioner for Patents, P.O Box 1450, Alexandria, VA 22313-1450, on June 3, 2005.

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